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Brief

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Richard ROTHKOPF

Serial No. 09/520,798

Filed: March 8, 2000

For: INCREMENTAL PROMOTION
FOR ELECTRONIC
COMMERCE

) BEFORE THE BOARD OF PATENT
) APPEALS AND INTERFERENCES

) Appeal No.:

) Examiner: John L. Young

) Group Art Unit: 3622

) July 21, 2003

7.30.03

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is a reply to the Examiner's Answer dated May 21, 2003, pursuant to 37 CFR § 1.193(b). The final rejection of claims 1-13, 15-21 and 23-25 of the above-identified application is improper and should be reversed.

The Answer Fails to Establish a *Prima Facie* Case of Unpatentability

The rejection of claims 1-13, 15-21 and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Leason in view of Reed is improper and should be reversed. As previously explained in detail, Leason does not disclose a method or apparatus for providing promotional awards to a visitor of an electronic commerce site by keeping track of the identity of visitors to the site, storing visitor parameter information pertaining to prior visits of identified visitors to the site, and crediting promotional awards by applying defined awards rules to the visitor parameter information stored for each visitor to the electronic commerce site, as disclosed and claimed in the present application.

Instead, Leason awards to individuals "e-points" in the form of game cards or receipts distributed at point-of-sale locations such as retail stores, movie theaters, etc. The game cards or receipts contain codes and designate Internet web sites at which an individual may validate the codes to obtain the "e-points." E-points may be accumulated only during a single on-line session by entering additional codes from additional game cards or receipts. In Leason, no identification of the visitor is performed. See col. 2, ll. 18-19. Consequently, no information pertaining to prior visits of the visitor to the web site is or can be stored in Leason. To the contrary, Leason simply allows an anonymous visitor to validate reward codes, and then redeem the codes in the form of access to a restricted web page or activation of a coded coupon, in real time.

The Examiner's Answer does not refute or disagree with Appellant's explanation of the Leason reference. Neither does the Examiner's Answer provide any concise explanation

of the Examiner's interpretation of what Leason discloses. Instead, the Answer simply repeats over 28 pages multiple prolix citations to the Leason prior art reference for each claim followed by a recitation of the entire claim, without ever attempting to correlate specific disclosure in Leason with specific limitations of the claims on appeal. The Answer apparently expects the Board to read through the entire Leason and Reed disclosures and make its own correlation of the prior art disclosure with the claim limitations. The Answer's stance does not rise to the threshold of establishing a *prima facie* showing of unpatentability. Nowhere in pages 4-31 of the Examiner's Answer does there appear a simple, concise correlation of specific pinpoint disclosures in Leason and/or Reed with each element of the claimed invention.

The Answer also repeats the erroneous hindsight reconstruction of the claimed invention in an attempt to show obviousness under 35 U.S.C. § 103 (see, e.g., Answer at 5 ("It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosures of Leason . . . would have been selected in accordance with the elements and limitations of claim 1 because such selection would have provided . . ."))).

The Answer repeats this clearly erroneous standard of obviousness under 35 U.S.C. § 103 in attempting to combine the Reed prior art reference with the Leason reference (see, e.g., Answer at 7 ("It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Reed with the teachings of Leason because such combination would have provided means "*to automate control of underlying communication operations . . .*"))).

Except for two instances, the Answer's "response" to Appellant's "arguments" at pages 31-39 consists of recitations of case law that are not germane to the rejections at issue, and irrelevant replies to incomplete snippets of Appellant's actual arguments. For example, the Answer mischaracterizes as an "argument" an incomplete quotation of a sentence from Appellant's brief concerning the disclosure of Leason, and responds with an equally incomplete quotation of another sentence from Appellant's brief. See Answer at 32. Nowhere does the Examiner's Answer show that Leason or Reed discloses any method or apparatus for providing promotional awards to visitors of an electronic commerce site by keeping track of the identity of visitors to the site, storing visitor parameter information pertaining to prior visits of identified visitors to the site, and crediting promotional awards by applying defined awards rules to the visitor parameter information stored for each visitor to the electronic commerce site.

The Answer does attempt to respond to specific claim limitations at pages 33 and 35. At page 33, the Answer attempts to correlate the "customer identification storage that contains unique identification information for each visitor to said site" of claim 1 with the "validation code" of Leason. However, as shown in Fig. 11 and Fig. 13, the "validation code" is simply the code given to the customer at the time of making an off-line purchase (such as by printing the code on a paper receipt) for the purpose of redeeming it online. As soon as the validation code is redeemed by registering it online as shown at step 1320, it is voided as shown at step 1330 so that the same validation code cannot be used more than once. This is completely irrelevant to the feature of the present invention that assigns visitor

identification information to each site visitor and keeps track of future site visits by storing the identification information.

At page 35, the Answer attempts to correlate the claim requirement of unique identification information with Leason's disclosed validation code. Again, the validation code disclosed by Leason is a code that corresponds to a particular award, and not to the identification of any specific customer or visitor of any electronic commerce site.

CONCLUSION

In view of the foregoing, claims 1-13, 15-21 and 23-25 are submitted to be directed to a new and unobvious method and system for offering promotional awards to visitors of electronic commerce sites, which is not taught or suggested by the prior art. The Honorable Board is respectfully requested to reverse all grounds of rejection and to direct the passage of this application to issue.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,
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